

REMARKS

In the final Office Action dated July 21, 2001, the examiner has rejected claims 16, 17, 20, 22, 23, 25-28, 32 and 33 under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi (US 2002/0129926) in view of Rotter (US 5,351,664).

Applicant submits that the references do not render the present application unpatentable in that the references lack all of the features of the claimed invention. A combination of the references, based on their teachings, would not result in the structure set forth in the present claims.

In particular, independent claim 16 defines two structures that are not shown or suggested in the base reference Yamaguchi, despite the Examiner's interpretation of that reference to suggest that those structures are present.

First, the claim defines the oil module as being provided with at least one channel for guiding oil and at least one channel for guiding water, one of the channels being an oil cooler bypass channel connecting an oil inlet of the oil cooler to an oil outlet of the oil cooler. The Examiner states that this is shown in Yamaguchi with "the oil module being provided with at least one channel for guiding oil (39a/b) and at least one channel for guiding water (40a/b), one of the channels being an oil cooler bypass channel (23) connecting an oil inlet of the oil cooler to an oil outlet of the oil cooler (fig 1)." The oil inlet in Yamaguchi is identified at element 19 which appears in the top right corner of figure 1. The only channel connected to the oil inlet 19 is the oil passage 39a which meanders through the oil cooler (paragraph [0025] lines 13 – 15). Only after the oil has passed completely through the oil cooler does it enter into the oil passage 39b formed in the oil turning passage 25a, and then enter the through hole 23 where it flows to the oil outlet. Thus, through hole 23 is not an oil cooler bypass channel as required by the claim and is not connected to the oil inlet 19, but rather is connected only to the oil turning passage 25a. Yamaguchi does not permit oil to bypass the oil cooler, but instead requires all of the oil to flow completely through the oil cooler.

As stated in the current specification, when oil is cold, and more viscous, a bypass channel is important to allow the oil to not be subjected to cooling, but rather to bypass the oil cooler. As the oil heats up and becomes less viscous, more of the oil flows through the oil

cooler, thus reducing the temperature of the oil to prevent thermal damage to the oil. In the case of Yamaguchi, all of the oil is required to flow through the oil cooler all of the time. None of the oil ever bypasses the oil cooler.

Secondly, the claim requires that at least a main part of the oil cooler bypass channel extends through the oil cooler base plate and is sealed towards at least one of an outside environment on the oil cooler side by the remaining oil cooler and on the carrier element side by the carrier element. At this point in the rejection, the Examiner switches the identification of the "bypass channel" and now states that the bypass channel is element 25a rather than element 23 as previously stated. There are still a couple of problems with the identification of this new channel as the bypass channel. Again, channel 25a is not an oil cooler bypass channel. Any oil entering channel 25a has already flowed through the entire oil cooler. Also, the channel 25a does not connect to the oil outlet, instead it connects to the through hole 23. Further, the channel 25a does not "extend through" the base plate as required by the claim. Instead, channel 25a is described as a depression in the cover member 25 (paragraph [0026] lines 10 -12). The channel is not sealed on the carrier element side by the carrier element. The elements corresponding to the claimed carrier element have been identified by the Examiner as elements 46 and 47 which are attached to the flanges 25c (see figs. 3 and 4) and which do not seal the channel 25a from the outside environment. It does not appear that the elements 46 and 47 even overlie the area of the channel 25a.

An advantage of having the bypass channel extending through the oil cooler base plate, rather than being formed in a depression, is discussed at paragraphs [0036] and [0045] of the present description, which is that the bypass channel may be manufactured together with the remaining base plate in one stamping operation. This advantage is not provided by the structure of Yamaguchi.

The Examiner relies on the teachings of Rotter only for a showing of an oil cooling device wherein an oil filter is attached to a carrier or the cooling device. Rotter is not relied on for a showing of the structure missing from Yamaguchi as discussed above.

The deficiencies of Rotter relative to the structure defined in the claim were discussed at length in applicant's previous responses filed April 6, 2010 and April 26, 2010, and are repeated here by reference.

In view of the foregoing, applicant submits that a combination of Yamaguchi and Rotter does not render claim 16, or any of its dependent claims unpatentable.

With regard to claim 17, the Examiner states that Yamaguchi discloses a slit “(25a)” extending over an entire thickness of the oil cooler base plate. As noted above, passage 25a is not a slit extending through the entire thickness of the base plate, but instead is shown as described as being formed as a depression in the plate.

With regard to claim 20 which defines that part of the oil cooler bypass channel extends through the carrier element, applicants submit that in Yamaguchi, no channel extends through what the Examiner has identified as the carrier element, that is elements 46 and 47.

With regard to claims 22 and 23, there is nothing in the Yamaguchi disclosure which even suggests that passages 25a or 23 have a throttling effect. There would be no reason for those passages to have a throttling effect, and in fact, the operation of the oil cooler would be impaired if those passages had a throttling effect since all of the oil is required to flow through those passages all the time, after it has already passed through the oil cooler. There is no disclosure in Yamaguchi as to the relative cross section areas of the various passages, and a single side sectional view is insufficient to determine the relative sizes of the cross sectional areas since it is unknown what the dimension of the various passages is in a direction into and out of the paper, such as in fig. 1. Further, since Yamaguchi does not describe that the drawings of the patent are to scale, arguments based on measurement of the drawings are of little value. MPEP 2125.

With regard to claim 25, again there is no channel area in the carrier element, so there can be no overlapping area with such a channel. Cap 43 of Yamaguchi is not located anywhere near the carrier elements 46, 47, and the channel 25a is also not in communication with any channel formed in the carrier elements 46, 47.

With regard to independent claim 32, the structure defined in this claim also includes an oil cooler bypass channel connecting an oil inlet of the oil cooler to an oil outlet of the oil cooler. The lack of such a bypass channel in Yamaguchi is discussed above and is repeated here by reference. Claim 32 also defines that the oil cool bypass channel extends through the oil cooler base plate. The channel 25a in Yamaguchi does not extend through the plate, but rather is formed in a depression in the plate. The discussion on this point with respect to claim 16 is repeated here by reference. Further, claim 32 defines that the main part of the oil cooler bypass

channel is sealed towards an outside environment on the carrier element side by the carrier element. This does not occur in Yamaguchi. The identified carrier elements 46, 47 do not seal any channels and do not come in contact with or overlie any channels. The deficiencies of Rotter discussed above with respect to claim 16 are repeated here. For each of these reasons, considered separately or in combination, applicant submits that claim 32 is patentably distinguishable over the combination of Yamaguchi and Rotter as suggested by the Examiner.

With regard to independent claim 33, the structure defined in this claim also includes an oil cooler bypass channel connecting an oil inlet of the oil cooler to an oil outlet of the oil cooler. The lack of such a bypass channel in Yamaguchi is discussed above and is repeated here by reference. Claim 33 also defines that the oil cool bypass channel extends through the oil cooler base plate. The channel 25a in Yamaguchi does not extend through the plate, but rather is formed in a depression in the plate. The discussion on this point with respect to claim 16 is repeated here by reference. Further, claim 32 defines that the main part of the oil cooler bypass channel is sealed towards an outside environment on the carrier element side by the carrier element. This does not occur in Yamaguchi. The identified carrier elements 46, 47 do not seal any channels and do not come in contact with or overlie any channels.

Claim 33 also defines that there is at least one channel extending through the carrier element for guiding oil and at least one channel extending through the carrier element for guiding water. The Examiner has identified elements 46 and 47 as the carrier elements, and neither of these elements has a channel therethrough for guiding water or oil. The Examiner does not even suggest that such channel exist in the carrier elements. Without a showing of such an element, the Examiner has not established a *prima facie* case of unpatentability of claim 33. The deficiencies of Rotter discussed above with respect to claim 16 are repeated here. For each of these reasons, considered separately or in combination, applicant submits that claim 33 is patentably distinguishable over the combination of Yamaguchi and Rotter as suggested by the Examiner.

Applicant points out that each of the claims previously withdrawn due to a species election requirement depend directly or indirectly from independent claim 16. Since independent claim 16 is patentable, as discussed above, applicant submits that each of the withdrawn claims should be reintroduced into the application and indicated to be allowable with the claims currently under consideration.

In view of the above discussion, applicant submits that all of the claims of the application are patentably distinguishable over the references relied on by the Examiner and applicant requests the Examiner to indicate that all of the claims (including the withdrawn claims) are allowed, and to pass the application to issue.

The Commissioner is hereby authorized to charge any additional fees which may be required for this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069.

Respectfully submitted,

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